

pre



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,037	05/24/2001	Fergus M. Wills	3399P044	4268

26529 7590 11/30/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

NOBAHAR, ABDULHAKIM

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/866,037	Applicant(s) WILLS, FERGUS M.	
	Examiner Abdulkhkim Nobahar	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-19 and 22-25 is/are allowed.
- 6) ☒ Claim(s) 1-15, 20, 21 and 26-40 is/are rejected.
- 7) ☒ Claim(s) 16 and 41 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/24/01, 6/12/03</u> | 6) <input type="checkbox"/> Other: ____ |

Specification

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitation "using the same cryptographic key for each service initiator in a second plurality of service initiators" in claim 3, is not described in the specification. On page 10, lines 1-12 of the specification applicant describes that the same key is used for all pull and push services if the origin server(s) and the service initiator(s) are associated together and have the same URI (Uniform Resource Identifier). In fact, on page 11, lines 1-8 of the specification applicant describes that if a service initiator uses a cryptographic key of a pull service in different URI, the request would be invalid.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2132

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Demello et al (2001/0036224 A1; hereinafter Demello).

Regarding claims 1 and 26, Demello discloses a method and system for delivering targeted data (a push service system) over a wireless network to a user while protecting the privacy of the user and also collecting information about users that may be used for commercial purposes (see, for example, abstract; [0001], [0002] and [0030]). Demello discloses a system in which an identifier of a wireless user is encrypted in a mediation server (corresponding to a proxy server) in order to protect user's personal information (see, for example, [0034] and [0092]). Demello further discloses a targeted data provider that transmits data (corresponding to the recited a request from a service initiator) intended for a mobile user to a profile server and then to the mediation server (see, for example, [0143] and [0147]). The mediation server decrypts the encrypted user's identifier in order to deliver the data to a particular user(s) (see, for example, [0149]).

Regarding claims 2, 3, 27 and 28, Demello discloses that the mediation server assigns a pseudo-random number (PSI) (corresponding to the recited cryptographic key) to each connected profile server (see, for example, [0035]-[0036] and [0135]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-15, 20, 21 and 29-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demello et al (2001/0036224 A1; hereinafter Demello) in view of Lincke et al (6,253,326 A1; hereinafter Lincke).

Regarding claims 4, 7, 29 and 32, Demello discloses that the mediation server generates an anonymous identifier (corresponding to the recited to encrypt the identifier) by using the assigned pseudo-random number (PSI) and a nonreversible hash algorithm (see, for example, [0135]). Demello also discloses that the mediation server transmits a substitute identifier for the user to a profile server (see, for example, [0021] and [0034]). Demello, however, does not expressly disclose the inclusion of encrypted identifier in a user request to a remote processing system.

Lincke discloses a method for secure data transmission between a wireless client and a web server via a proxy server (see, for example, Fig. 1 and col. 3, line 35-col. 4,

Art Unit: 2132

line 15). Lincke also discloses that the transmitted data packets to a proxy server in the user request, indicate (a parameter included in every packet header) that the wireless user request (corresponding to the recited based on a request from the mobile device) to be encrypted at the proxy server for transmission to a mail or a web server (corresponding to the recited request to a remote processing system) (see, for example, col. 35, lines 29-37; col. 68, lines 1-6; col. 83, lines 17-39). In such cases, Lincke describes that the proxy server utilizes secure protocols such as SSL and S-HTTP (i.e., HTTPS) to communicate with the mail or web servers over an insecure network such as Internet (see, for example, col. 83, lines 40-67; col. 90, lines 54-60; col. 111, lines 18-28).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a secure communication mechanism to encrypt the user identifier in the user request to a web server as taught in Lincke in the system of Demello, because it would provide for protection of user's confidential information (i.e., identifier) (Lincke, col. 83, lines 46-54).

Regarding claims 5, 6, 30 and 31, Demello discloses a targeted data provider that transmits data (corresponding to the recited a request from a service initiator) intended for a mobile user to a profile server and then to the mediation server (see, for example, [0143] and [0149]). The mediation server decrypts the encrypted user's identifier in order to deliver the data to a particular user(s) (corresponding to the recited to validate a request). Demello further discloses that the mediation server

Art Unit: 2132

(corresponding to the recited a proxy server) is connected to the wireless network and the Internet/wired network (see, for example, Fig. 2).

Regarding claims 8 and 33, Demello discloses that when a profile server receives a request from a targeted data provider to send information to a wireless user, the profile server first identifies the targeted user(s) based on the provider request and then the mediation server decrypts the user's identifier in order to transmit the provider's request to the wireless user (see, for example, [0143]-[0149]). Combination of the operations performed by the profile and the mediation servers constitute validation of a provider request and determination of the intended mobile user.

Regarding claims 9 and 34, Demello discloses a wireless communication system in which an identifier of a wireless user is encrypted in a mediation server (corresponding to a proxy server) in order to protect user's personal information (see, for example, [0034] and [0092]). Demello further discloses that the encrypted identifier is used to deliver the targeted data transmitted by providers to wireless users (see, for example, [0143]-[0149]). Demello, however, does not expressly disclose that the encrypted user identifier is included in the request transmitted from the mediation server to a service provider.

Lincke discloses that the proxy server transmits the user request to a web server (see, for example, Fig. 1). Lincke also discloses the proxy server encrypts the user request based on an indicated parameter in the data packet headers (corresponding to

Art Unit: 2132

the recited user request) and transmit the encrypted user request to a remote web server (see, for example, col. 35, lines 29-37; col. 68, lines 1-6; col. 83, lines 17-39; Fig. 13).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a secure communication mechanism to encrypt the user identifier in the user request to a web server as taught in Lincke in the system of Demello, because it would provide for protection of user's confidential information (i.e., identifier) (Lincke, col. 83, lines 46-54).

Regarding claims 10 and 35, this claim is rejected as applied to like elements of claim 2.

Regarding claims 11 and 36, this claim is rejected as applied to like elements of claim 5.

Regarding claims 12, 20 and 37, Demello discloses a mediation server that assigns pseudo-random numbers (corresponding to the recited an association) to a remote (profiling) servers and uses the assigned numbers in conjunction with the address of the destination server to generate an anonymous identifier (corresponding to the encrypted identifier) for transmission to the remote profile server (see, for example, [0035]; [0134]-[0135]). This implies that the cryptographic material is associated with the remote server address. The mediation server of Demello also maintains cryptographic

Art Unit: 2132

keys for encryption and decryption of wireless users identifiers (see, for example, [0034] and [0135]). Demello, however, does not expressly disclose that the mediation server to receive requests from wireless users, encrypt and transmit them to a remote server.

Lincke discloses a proxy server that encrypts a received request from a user and transmits it over the Internet to a web server based on an indicated parameter in the user data packets header (see, for example, Fig. 1; col. 68, lines 1-6; col. 83, lines 17-39; col. 90, lines 54-60; col. 111, lines 18-28).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a secure communication mechanism to encrypt the user identifier in the user request to a web server as taught in Lincke in the system of Demello, because it would provide for protection of user's confidential information (i.e., identifier) (Lincke, col. 83, lines 46-54).

Regarding claims 13 and 38, this claim is rejected as applied to like elements of claim 2.

Regarding claims 14 and 39, Demello discloses that the mediation server uses the address of the destination server to generate the anonymous identifier (corresponding to the encrypted identifier) (see, for example, [0035] and [0135]). This implies that the cryptographic material is associated with the remote server address.

Regarding claims 15, 21 and 40, these claims are rejected as applied to like elements of claim 7.

Allowable Subject Matter

1. Claims 16 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 17-19 and 22-25 are allowed.
3. The following is an examiner's statement of reasons for allowance of the claims 17-19:
4. The primary reasons for the allowance of the independent claims 17 and 22 are the inclusion of the following limitation that is not found in the prior art and they are uniquely distinct features. The closest prior arts are Demello et al (2001/0036224 A1) and Lincke et al (6,253,326 A1). Demello et al discloses a method and system for delivering targeted data (a push system) over a wireless network to a user while protecting the privacy of the user and also collecting information about users that may be used for commercial purposes. Lincke et al discloses a method for secure transmission of a wireless user request directed to

a web server and the web server response to the user over a wireless network and the Internet via a proxy server. These two arts, singularly or in combination, fail to anticipate or render the following limitation:

“Claims 17 and 22: if the stored association includes a cryptographic key associated with the service initiator, using said cryptographic key to decode a device identifier in the request from the service initiator.”

“Claim 25: sending a request to push second information to the mobile client device by including the encrypted initiator in the request to push the second information to the client device, such that the encrypted identifier in the request to push the second information is used to validate the request to push the second information.”

5. The dependent claims 18, 19 and 23 are allowed because they were originally found to include a unique feature not found in the closest abovementioned art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 2002/0186683 A1 to Buck et al.

US Patent No. 2001/0047474 A1 to Takagi et al.

US Patent No. 6,795,924 to Kiessling et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abdulhakim Nobahar
Examiner
Art Unit 2132



AN

November 23, 2004



THOMAS R. PEESO
PRIMARY EXAMINER